

## **REMARKS**

The last Office Action of May 22, 2007 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1, 4, 5, 8, 10-20 are pending in the application. Claims 1, 11, 14, 16 have been amended. Claims 5, 13, 18 have been canceled. No claim has been added. No amendment to the specification has been made. No fee is due.

It is noted that claim 16 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 4,914,329 to Ottersbach.

Claims 11, 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 6,548,981 to Ishii et al. It is noted for the record that this rejection is treated as a rejection pursuant to 35 U.S.C. §102(e) because the publication of this patent is not more than one year before the filing date of the instant application.

Claims 4, 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ottersbach in view of U.S. Pat. No. 6,346,810 to Cho et al.

Claims 5, 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ottersbach in view of U.S. Pat. No. 6,529,135 to Bower et al.

Claims 12, 15, 17, 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ishii et al. in view of Cho et al.

Claims 13-14, 18-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ishii et al. in view of Bower et al.

## **REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

The Examiner has maintained the rejection of claim 16 because of the reference to "permanent magnets" with the reasoning that "the rotor has many

forms/types of rotor". In other words, there are rotors that do not require to have "permanent magnets". While applicant readily concedes that rotor configuration come in various designs, the subject matter of claim 16 relates to those rotors that have permanent magnets. It is immaterial, whether there are rotors without permanent magnets. Configurations of rotors with permanent magnets are known to the artisan, and common sense would have prompted a person of ordinary skill in the art to consider "permanent magnets" as heat source. It is therefore applicant's belief that the instant specification satisfies the requirement under section 112, first paragraph.

Withdrawal of the rejection of the claim 16 under 35 U.S.C. §112, first paragraph is thus respectfully requested.

#### **REJECTION UNDER 35 U.S.C. §§102 AND 103**

The rejection of claim 1, 11, 16 under 35 U.S.C. 102(b) and (e) is moot as a result of the incorporation of claims 5, 13, 18 in claims 1, 11, and 18, respectively. Withdrawal of the rejection of claims 1, 11, 16 under 35 U.S.C. §102 is thus respectfully requested.

Applicant thus directs his argumentation to the rejection of claims 5, 13, and 18.

The subject matter of claims 5, 13, and 18, which has now been incorporated in the combination as set forth in claims 1, 11, 16, respectively, is directed to the provision of an evaluation device which receives information from the temperature radiation detector at predetermined time instances for establishing a thermographic image of the electric machine.

With respect to Ottersbach and Ishii et al., the Examiner readily concedes that the disclosure thereof is silent as to the provision of an evaluation device, as set forth in previous claims 5, 13, 18, now incorporated in claims 1, 11, 16, respectively. To bridge the absence of teaching, the Examiner applied the Bower

et al. reference and noted that "Bower et al. disclose the exception set forth above."

Applicant wishes to note that this Examiner's rejection is confusing and allows applicant only to speculate as to the portions of the Bower reference relied upon. The Examiner clearly failed to comply with the practice set forth in §706.02(j) of the Manual of Patent Examining Procedure which contains a discussion of what an Examiner should set forth in an Office Action under 35 U.S.C. §103(a). To make a case for obviousness, a showing must be provided that is clear and particular and beyond "broad conclusory statement about the teaching of multiple references" (*Brown & Williamson Tobacco*, 229 F.3d at 1125 (Fed. Cir.)). Accordingly, the Examiner is requested to indicate to applicants which specific portions (page and line or figure) of each of the references the Examiner refers to base his/her rejection on. *Ex parte Gambogi*, 62 USPQ2d, 1209 (Board of Patent Appeals and Interferences), *Ex parte Jones*, 62 USPQ2d, 1206 (Board of Patent Appeals and Interferences). See also 83USPQ2d, 1376.

A review of the Bower et al. reference did not reveal an evaluation device as set forth in claims 1, 11, 16.

For the reasons set forth above, it is applicant's contention that neither Ottersbach, nor Ishii et al., nor Bower et al., nor any combination thereof teaches or suggests the features of the present invention, as recited in claims 1, 11, 16.

As for the rejection of the retained dependent claims, these claims depend on claims 1, 11, 16, respectively, share their presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Withdrawal of the rejection under 35 U.S.C. §103(a) and allowance of claims 1, 4, 8, 10-12, 14-17, 19-20 are thus respectfully requested.

#### **CITED REFERENCES**

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the claims on file. It is thus felt that no specific

discussion thereof is necessary.

### CONCLUSION

Applicant believes that when reconsidering the claims in the light of the above comments, the Examiner will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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